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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,092	02/26/2002	Timothy J. Clemens	56471US010	8110
32692	7590	05/05/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			KEEHAN, CHRISTOPHER M	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s) <i>Je</i>	
	10/083,092	CLEMENS ET AL.	
	Examiner	Art Unit	
	Christopher M. Keehan	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 19-23 and 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 24, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0404</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

It is requested that applicant update the specification as to the status of the now abandoned parent application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, 24, 29, and 30, drawn to an article, classified in class 428, subclass 355R.
- II. Claims 19-23, drawn to a fiber impregnated article, classified in class 428, subclass 320.2.
- III. Claim 25, drawn to an adhesive bonding method, classified in class 156, subclass 297.
- IV. Claim 26, drawn to an adhesive bonding method, classified in class 156, subclass 88.
- V. Claims 27 and 28, drawn to an adhesive bonding method, classified in class 156, subclass 94. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product

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(MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a protective film that does not fiber reinforcement and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions of Group I and Groups III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process of using that product, such as that of Groups IV or V.

Inventions of Group I and Groups IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the

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product can be used in a materially different process of using that product, such as that of Groups III and V.

Inventions of Group I and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process of using that product, such as that of Groups III and IV.

Inventions of Groups III-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated. Group III is a method of sealing an edge, Group IV is a method of sealing adjacent films, and Group V is a method of sealing a damaged area.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Scott Bardell on April 7, a provisional election was made with traverse to prosecute the invention of Group 1, claims 1-18, 24, 29, and 30. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 19-23, and 25-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, 8-10, 13-15, 18, 24, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoyle et al. (WO 99/64235). Regarding claims 1, 4, 8-10, and 24, Hoyle et al. disclose a protective article comprising a backing comprising a fluorinated polymer that is not perfluorinated, more specifically the instantly claimed polymers (page 6, lines 11-25 and page 7, lines 6-10) and a curable adhesive layer on at least one surface thereof (page 8, lines 10-25).

Regarding claim 5, Hoyle et al. disclose the curing temperature as claimed (page 28, lines 21-29).

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Regarding claims 13-15, and 18, Hoyle et al. disclose the instantly claimed substrates (page 1, lines 22-28 and page 3, line 24-page 5, line 21).

Regarding claim 30, Hoyle et al. disclose a patterned structure (page 7, lines 18-26).

Claims 1, 2, 6-9, 11, 24, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Parsonage et al. (WO 99/32557). Regarding claims 1, 2, 6-9, and 24, Parsonage et al. disclose a protective article comprising a backing comprising a fluorinated polymer that is not perfluorinated, more specifically the instantly claimed polymers and a curable adhesive layer on at least one surface thereof, more specifically the instantly claimed adhesive (page 5, lines 12-25 and page 14, line 21-page 15, line 13).

Regarding claim 11, Parsonage et al. disclose an epoxide resin by disclosing 3,158,581 (Vandenburg) as claimed (page 5, lines 19-22). Vandenburg discloses epoxides selected from the group as instantly claimed (col.1, line 26-col.2, line 29).

Regarding claim 29, Parsonage et al. disclose wherein the adhesive composition comprises an anticorrosion additive (page 14, lines 28-30). As applicant has not defined an anticorrosion additive, it is the examiner's position that calcium hydroxide can act as an anticorrosion additive.

Claims 1-3, 16, 17, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (4,670,089). Regarding claims 1, 2, and 24, Hanson discloses a

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protective article comprising a backing comprising a fluorinated polymer that is not perfluorinated, more specifically the instantly claimed polymers and a curable adhesive layer on at least one surface thereof, more specifically the instantly claimed adhesive (col.3, line 3-col.4, line 41).

Regarding claim 3, Hanson discloses a urethane adhesive by disclosing Blum et al., 4,507,456 (col.3, lines 63-65). Blum et al. disclose urethane adhesives (entire document).

Regarding claims 16 and 17, Hanson discloses substrates as claimed (page 12, lines 6-31 and paragraph bridging pages 13 and 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parsonage et al. (WO 99/32557) in view of Neumann et al. (5,889,125). Parsonage et al., as applied above, are as set forth and incorporated herein. Parsonage et al. do not appear to specifically disclose a curing agent as claimed. Parsonage et al. do disclose diamine curing agents (page 5, lines 23-25). Neumann et al. disclose a composition for applying to many types of substrates (col.6, line 50-col.7, line 8) comprising a modified bisphenol A epoxy resin (col.6, lines 28-34) and a curing agent of polymer diamines,

more specifically 4,7,10-trioxatridecane-1,13-diamine (col.4, lines 10-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a polymer diamine as taught by Neumann et al. in the resin composition of Parsonage et al. because Neumann et al. teach that using a polymer diamine curing agent with an epoxy resin produces a composition that is reactive at lower temperatures and high atmospheric humidity, resulting in a higher quality and more versatile product.

Claims 2, 6, and 11 are rejected under 35 U.S.C. are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsonage et al. (WO 99/32557) in view of Vandenburg (3,158,581). Parsonage et al. disclose an epoxide resin by disclosing 3,158,581 (Vandenburg) as claimed (page 5, lines 19-22). Vandenburg discloses epoxides selected from the group as instantly claimed (col.1, line 26-col.2, line 29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an epoxide resin as taught by Vandenburg in the composition of Parsonage et al. because Vandenburg is disclosed by Parsonage et al. as teaching epoxide resins for use in Parsonage et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is

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(571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu S. Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan *CWK*

April 27, 2004

DAVID J. BUTTNER
PRIMARY EXAMINER

David Buttner